

**REMARKS**

Reconsideration and withdrawal of the rejections/objections and allowance of all of pending Claims 1-50, is respectfully requested at this time for the reasons provided in the earlier response and in addition for the reasons set forth herein..

In response to the Examiner's request (p. 2, ¶ 3), and to comply with 37 C.F.R. 1.173(c), the Applicants submit herewith an explanation of the support in the disclosure of the patent for Claims 19-50. In a good faith effort to comply, the Applicants have indicated references to the 13 column(s) of the patent disclosure submitted with the Reissue Patent Application Transmittal, dated October 2, 2000, and also, where possible, more specifically indicated references to the column(s) and line number(s) of the issued patent. Thus, Applicants believe that each amendatory change for Claim 19-50 is supported by the original disclosure of the patent, and the objection to the preliminary amendment is overcome and should be withdrawn.

Applicants respond to the grounds of rejection/objection set forth in the Final Office Action dated February 26, 2002 ("Office Action") as follows:

In the Office Action on page 2, ¶1, the Examiner stated that the Reissue Oath/Declaration filed with this application was defective because the error which was relied upon to support the reissue application was not an error upon which reissue can be based. The Examiner referred back to the reasons relied upon in the Office Action dated May 25, 2001, wherein the Examiner cited *In re Orita*, 550 F.2d 1277 (C.C.P.A. 1977), and further stated, on pages 2-4, ¶4, that the Applicants' arguments were not found persuasive and, in particular, that *In re Orita* should apply to the facts of this reissue application.

These rejections/objections are respectfully traversed and reconsideration is requested.

At the outset, Applicants note that, contrary to the Examiner's assertions, the Applicants traversed each of the restriction requirements made by the Examiner in each of the prior applications, *i.e.*, Ser. Nos. 07/995/289; 08/163,010; and 08/702,922. The Applicants did not acquiesce to them and did not agree to file a divisional, but instead argued that the claims should have been examined together.

Specifically, in Application Ser. No. 07/995/289, the Applicants, during a telephone conversation with the Examiner on May 3, 1993, traversed the restriction requirement imposed (Examiner's Amendment, dated May 4, 1993, p. 3). Also, in Application Ser. No. 08/163,010, the Applicants traversed the restriction requirement on the grounds that the claims were "not patentably distinct" from each other and "should be examined together" (Response to Restriction Requirement, dated October 10, 1994, p. 2). The Applicants noted that "[t]o do otherwise merely serves to increase costs to applicants and the Patent Office" (*Id.*). Lastly, in Application Ser. No. 08/702,922, the Applicants traversed the requirement for restriction and stated that the claims were "clearly all interrelated" and that "all of the groups of claims should be considered and examined together" (Response to Restriction Requirement, dated February 5, 1997, p. 2).

The claims added in this reissue application are tied directly to the process claims which were patented in the patent for which reissue is sought and should have been prosecuted with such process claims when they were presented in parent application, Serial No. 08/702,922 (U.S. Patent 5,817,261). In addition, the Applicants are not relying upon the failure to file a timely divisional application in any of these previous applications as the error upon which this reissue application is based. As a result, as the Applicants have argued previously, the facts of this reissue application are distinguishable from those of *In re Orita* because, in that case, the

restriction was not traversed resulting in the missed opportunity to file a timely divisional application.

A recent case is instructive with respect to Applicants arguments. In *In re Doyle*, the Federal Circuit, in reversing a decision by the Board of Patent Appeals and Interferences (upholding an Examiner's rejection of a reissue declaration), held that the inventor properly presented an error correctable by reissue. *In re Doyle*, 293 F.3d 1355 (Fed. Cir. 2002). The Court particularly noted that the doctrine embodied in *In re Orita* did not apply because of several "critical" distinctions. *Doyle*, 293 F.3d at 1360. Specifically, the Court held that (a) the applicant never asserted the reissue claims or anything similar to them in the original application; (b) never agreed to prosecute the reissue claims in a divisional; and (c) should have prosecuted the reissue claims with the claims of the elected group. *Id.*

Similarly, the Applicants have argued that the facts of this case differentiate it from *In re Orita* because the reissue claims presented were not presented in the original, the restriction requirements were all traversed, and that the claims should have prosecuted together. The Federal Court in *Doyle* particularly noted that "it was crucial that the applicant [Doyle] explicitly agreed to the requirement of independent prosecution of the disputed claims," which is in stark contrast to the present facts wherein the Applicants have repeatedly asserted that the claims presented should be examined together. *Id.* Moreover, the Examiner admits that the "[a]pplicants are now claiming the additive in broader form than it was previously claimed" (Final Office Action, dated February 26, 2002, p. 3), which is similar to the facts in *Doyle* where the reissue claims were broader than the issued patent claims, thus resulting in an error correctable by reissue. *Id.*

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Based upon the foregoing, Applicants believe that the rejection/objection to the Reissue Oath/Declaration filed with the application as defective due to an improper grounds for reissue has been overcome and should be withdrawn. Applicants believe that all items raised in the February 26, 2002 Final Office Action have been responded to and that the rejections/objections have been overcome. Accordingly, the application is in condition for allowance and the same is respectfully requested.

Date: August 26,2002

Respectfully submitted,

  
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**Support for Claims 19-50**

Pursuant to 37 C.F.R. 1.173(c), the Applicants provide below an explanation of the support in the disclosure of the issued patent for Claims 19-50, with references to the 13 column(s) of the patent disclosure submitted with the Reissue Patent Application Transmittal, dated October 2, 2000, as well as references to the column(s) and line number(s) of the issued patent.

The support for Claim 19 can be found in the patent disclosure in column 6 (col. 6, ll. 1-67 of the issued patent), disclosing the recited additive.

The support for Claim 20, which depends from Claim 19, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph 1 (col. 7, ll. 1-23 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 21, which depends from Claim 20, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph 1 (col. 7, ll. 1-7 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 22, which depends from Claim 21, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph 1 (col. 7, ll. 1-7 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 23, which depends from Claim 21, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph

1 (col. 7, ll. 1-7 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 24, which depends from Claim 21, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph 1 (col. 7, ll. 7-13 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 25, which depends from Claim 24, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph 1 (col. 7, ll. 10-12 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 26, which depends from Claim 21, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph 1 (col. 7, ll. 14-21 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 27, which depends from Claim 26, can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and column 7, paragraph 1 (col. 7, ll. 14-21 of the issued patent), disclosing the recited blowing agent, solid organic acids, and alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 28, which depends from Claim 19, can be found in the patent disclosure in column 6 (col. 6, ll. 1-4 and 7-10 of the issued patent), disclosing the recited alpha-methylstyrene and Vicat softening temperature.

The support for Claim 29, which depends from Claim 28, can be found in the patent disclosure in column 6 (col. 6, ll. 1-4 and 14-25 of the issued patent), disclosing the recited alpha-methylstyrene physical characteristics.

The support for Claim 30, which depends from Claim 19, can be found in the patent disclosure in column 6 (col. 6, ll. 26-38 of the issued patent), disclosing the recited rubbery block copolymer.

The support for Claim 31, which depends from Claim 30, can be found in the patent disclosure in column 6 (col. 6, ll. 38-67 of the issued patent), disclosing the recited rubbery block copolymer.

The support for Claim 32, which depends from Claim 31, can be found in the patent disclosure in column 6 (col. 6, ll. 53-55 and 57-61 of the issued patent), disclosing the recited rubbery block copolymer.

The support for Claim 33 can be found in the patent disclosure in column 6, paragraph 1 (col. 6, ll. 1-4 of the issued patent) and in column 3, starting at the fifth full paragraph to column 5 (col. 3, l. 49 to col. 5, l. 24 of the issued patent), disclosing the recited foamable polymer compositions.

The support for Claim 34, which depends from Claim 33, can be found in the patent disclosure in column 5 (col. 5, ll. 28-54 of the issued patent), disclosing the recited foamable polymer composition, including styrene or a blend of styrene and a rubbery polymer.

The support for Claim 35, which depends from Claim 33, can be found in the patent disclosure in column 5 (col. 5, ll. 29-34 of the issued patent), disclosing the recited foamable polymer composition, including styrene or a blend of styrene and a rubbery polymer.

The support for Claim 36, which depends from Claim 33, can be found in the patent disclosure in column 5 (col. 5, ll. 29-34 of the issued patent), disclosing the recited foamable polymer composition, including styrene or a blend of styrene and a rubbery polymer.

The support for Claim 37, which depends from Claim 33, can be found in the patent disclosure in column 5 (col. 5, ll. 27-67 of the issued patent), disclosing the recited foamable polymer composition, including styrene or a blend of styrene and a rubbery polymer.

The support for Claim 38, which depends from Claim 33, can be found in the patent disclosure in column 6 (col. 6, ll. 5-10 of the issued patent), disclosing the recited claimed elements.

The support for Claim 39, which depends from Claim 33, can be found in the patent disclosure in column 6 (col. 6, ll. 14-25 of the issued patent), disclosing the recited claimed elements.

The support for Claim 40, which depends from Claim 33, can be found in the patent disclosure in column 6 (col. 6, ll. 26-45 of the issued patent), disclosing the recited claimed elements.

The support for Claim 41, which depends from Claim 40, can be found in the patent disclosure in column 6 (col. 6, ll. 38-67 of the issued patent), disclosing the recited claimed elements.

The support for Claim 42, which depends from Claim 41, can be found in the patent disclosure in column 6 (col. 6, ll. 53-55 and 57-61 of the issued patent), disclosing the recited claimed elements.

The support for Claim 43, which depends from Claim 33, can be found in the patent disclosure in column 3, starting at the fifth full paragraph to column 5 (col. 3, l. 49 to col. 5, l. 24 of the issued patent) and in column 7 (col. 7, ll. 1-23 of the issued patent), disclosing the recited blowing agent.

The support for Claim 44, which depends from Claim 43, can be found in the patent disclosure in column 7 (col. 7, ll. 1-7 of the issued patent), disclosing the recited blowing agent, solid organic acids, alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 45, which depends from Claim 44, can be found in the patent disclosure in column 7 (col. 7, ll. 1-7 of the issued patent), disclosing the recited blowing agent, solid organic acids, alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 46, which depends from Claim 44, can be found in the patent disclosure in column 7 (col. 7, ll. 1-7 of the issued patent), disclosing the recited blowing agent, solid organic acids, alkaline metal carbonate or alkaline metal bicarbonate.

The support for Claim 47, which depends from Claim 44, can be found in the patent disclosure in column 7 (col. 7, ll. 7-13 of the issued patent), disclosing the recited blowing agent, solid organic acids, alkaline metal carbonate or alkaline metal bicarbonate, as well as ratios and combinations.

The support for Claim 48, which depends from Claim 47, can be found in the patent disclosure in column 7 (col. 7, ll. 7-13 of the issued patent), disclosing the recited blowing agent, solid organic acids, alkaline metal carbonate or alkaline metal bicarbonate, as well as ratios and combinations.

The support for Claim 49, which depends from Claim 44, can be found in the patent disclosure in column 7 (col. 7, ll. 14-16 of the issued patent), disclosing the recited combination.

The support for Claim 50, which depends from Claim 49, can be found in the patent disclosure in column 7 (col. 7, ll. 13-23 of the issued patent), disclosing the recited combination.